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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,639	05/16/2001	Nissim Darvish	20066.73	3851

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WILLIAM H. DIPPert  
REED SMITH L.L.P.  
599 LEXINGTON AVENUE  
NEW YORK, NY 10022

EXAMINER

KHAN, OMAR A

ART UNIT

PAPER NUMBER

3762

DATE MAILED: 04/18/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

**Office Action Summary**

Application No.

09/720,639

Applicant(s)

DARVISH ET AL.

Examiner

Omar A Khan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 and 49-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 49-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7 6) ☐ Other:

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## DETAILED ACTION

### *Election/Restrictions*

1. Claims 16-48 and 64-99 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 11.

Applicant's election with traverse of Species I (claims 1-15 and 49-63) in Paper No. 11 is acknowledged. The traversal is on the ground(s) that the respective subject matter is sufficiently closely related that the respective searches would be substantially co-extensive and not burdensome to the Examiner. This is not found persuasive because, as stated in the previous action, the species do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: each of the species has a different special technical feature, namely, Species I has a pacing signal duration three times a chronaxie time, Species II has a pacing signal having a plurality of biphasic pulses and Species III has a pacing signal amplitude at least three times as great as the threshold for pacing the heart.

The requirement is still deemed proper and is therefore made FINAL.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague and indefinite since the claim does not state whether the chronaxie time is predetermined or not. If not, then the claim is incomplete for omitting an element to determine a chronaxie time. Further, the claim is vague and indefinite for citing the limitation "electrodes, which convey electrical signals to respective cardiac muscle" since it would seem a connection to the human body is being claimed. Apparatus claims cannot claim human body parts. Examiner suggests - electrodes, adapted to convey electrical signals to respective cardiac muscle-. In addition, the cited limitation "electrical signals" is inferentially included and not positively recited in the claims.

Claims 4 and 52 are vague and indefinite for citing the limitation "less than approximately 100ms" since this would include pulse durations 0ms, 1ms and 2ms not disclosed in the specification. Clarification is requested in the next communication.

Claim 5 is vague and indefinite for citing the limitation "cardiac muscle segments to which the one or more electrodes are applied" since it would seem a connection to the human body is being claimed. Apparatus claims cannot claim human body parts. Examiner suggests - cardiac muscle segments to which the one or more electrodes are adapted to be applied-.

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Claim 49 is vague and indefinite for citing the limitation "at three times" since the specification and the other claims cite the limitation "greater than three times". Examiner assumes that applicant meant "greater than three times". Clarification is requested in the next communication.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-4, 6, 7, 10, 11, 14, 15, 49-52, 54, 55, 58, 59, 62, 63 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Mouchawar (US Patent 5,906,633). Mouchawar discloses the claimed invention throughout the specification and particularly in column 6, 43-61.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 5, 8, 9, 10, 49, 53, 56, 57 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann et al (US Patent No 6,311,089). Mann discloses all of the claimed limitations throughout the specification but particularly in column 17, lines 36-58, and column 18, lines 1-20, but does not explicitly speak to pacing at a duration *greater than* three times a chronaxie. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and apparatus of pacing of Mann to include pacing at a duration greater than three times a chronaxie since it was well known in the art to pace at a duration and strength as high as possible for maximizing patient safety parameters.

5. Claims 12, 13, 60 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mouchawar. Mouchawar discloses all of the claimed limitations but does not explicitly speak to

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pulse train periods of 5ms and 20ms. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and apparatus of pacing of Mouchawar to include pulse train periods of 5ms and 20ms since it was well known in the art to vary the pulse train period for providing therapies specific to the patient and the arrhythmia being treated.


*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Omar A Khan whose telephone number is (703) 308-0959. The examiner can normally be reached on M-F 9AM-6PM.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0873.

  
Omar A Khan  
April 15, 2003

  
GEORGE R. EVANISKO  
PRIMARY EXAMINER  
4/16/3